

## REMARKS

This is a full and timely response to the outstanding Final Office Action mailed June 8, 2005. Upon entry of this response, claims 2-4, 10-16, and 35-54 are pending in the application. In this response, claims 4, 11 – 13, and 35 - 50 have been amended. Applicants respectfully request that the amendments being filed herewith be entered and request that there be reconsideration of all pending claims.

### 1. Examiner Interview

An in-person interview took place at the United States Patent and Trademark Office on September 16, 2005. The attendees were Examiner Jonathan Ouellette and Applicants' representative, Jeff Kuester. During that interview, the parties discussed 35 U.S.C. § 101 and potential claim amendments that are embodied in the present amendments. Applicants wish to thank Examiner Ouellette for his time.

### 2. Rejection of Claims under 35 U.S.C. § 101

Claims 2-4, 10, 35-40, and 48-54 have been rejected under § 101 as allegedly being directed to non-statutory subject matter. While Applicants do not agree with that rejection, Applicants have nonetheless accordingly amended independent claims 35 and 48 in order to advance prosecution.

### 3. Rejections over Aplen, Jr. (US 6,044,354)

All of the presently pending claims were rejected either under § 102(e) as allegedly anticipated by Asplen or under § 103(a) as allegedly obvious over Aplen. Furthermore, additional elements were found to allegedly be non-functional descriptive material having no functional involvement in the claims.

While Applicants do not agree with those rejections or the associated interpretations and conclusions, Applicants respectfully submit that in view of the above amendments, all of the presently pending claims are now in condition for allowance. While Applicants do not admit that

the cited reference discloses the subject matter as stated in the Office Action, or that other elements are non-functional descriptive material as stated, Applicants submit that the pending claims are allowable for at least the reason that they all refer to an intellectual property utilization system determining a utilization recommendation based upon intellectual property licensing rights marketability data as specifically claimed throughout the various claims.

Applicants further submit that examples providing elements of support for the above claims are found on one or more of the following pages of the specification 9 – 17, 46 - 51, 71 – 75, and 177 – 210. Of course, by identifying such support in the present specification, Applicants do not intend to thereby limit the presently pending claims in any matter.

#### 4. Official Notice

According to the Office Action, “official notice is given that marketing and marketing/business assessments were well known at the time the invention was made, to include the assessment techniques/criteria disclosed in claims 36-38 and 42-45.” Applicants traverse this finding and submit that this subject matter should not be considered well-known for the reason that this subject matter is complex in its nature and is, therefore, likely to be obscured from those reasonably skilled in the art. The assessments of marketability and specific criterion expressed in claims 36 – 38 and 42 – 45 are also very detailed in their nature, which provides another reason that this subject matter should not be considered well-known. Consequently, Applicants respectfully traverse this conclusion of official notice and request additional evidence in support thereof if this finding is maintained and not rendered moot by the above amendments.

## **CONCLUSION**

Applicants respectfully request that all outstanding objections and rejections be withdrawn and that this application and presently pending claims 2-4, 10-16, and 35-54 be allowed to issue. Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known for at least the specific and particular reason that the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support each and every such conclusion. If the Examiner has any questions or comments regarding Applicants' response, the Examiner is encouraged to telephone Applicants' undersigned counsel.

Respectfully submitted,

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& RISLEY, L.L.P.**

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